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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
|--|-------------|----------------------|----------------------------|------------------------|
| 09/728,340   | 12/01/2000  | Tom Vicknair         | P/2167-253                 | 5053                   |
| 21967 7590 07/24/2007<br>HUNTON & WILLIAMS LLP<br>INTELLECTUAL PROPERTY DEPARTMENT<br>1900 K STREET, N.W.<br>SUITE 1200<br>WASHINGTON, DC 20006-1109 |             |                      | EXAMINER<br>DASS, HARISH T |                        |
|  |             |                      | ART UNIT<br>3693           | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>07/24/2007    | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/728,340             | VICKNAIR ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Harish T. Dass         | 3693                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-10,36-41 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,36-41 and 43-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### Status of Claims:

Claims: 7, 11-35, 42 and 46-66 are canceled.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-10 and 36-41 and 43-45 remain rejected Geer (US 5,930,778) in view of Gruenwald (US 6,457,006).

Re. Claims 1, Geer discloses a system for expedited processing of checks and cash items received by a payee, electronic files that mirror paper cash letters and detail records [Figures 1-2; col. 1 line 1 to col. 6 line 20],

receiving an electronic cash presentment (ECP or transmission of the transactional check data) file, the ECP file containing first records representing paperbased banking transactions [col. 2 lines 4-15; col. 4 line 26 to col. 5 line 9; col. 7 lines 25-61; col. 9 lines 1-10; col. 18 lines 1-18],  
for each of the first records, assigning a unique first item sequence number to each respective first record [col. 7 lines 38-58],

receiving the paper-based banking transactions after having received the ECP file, [col. 4 line 45 to col. 5 line 10; col. 10 lines 50-57],

generating second records representing the paper-based banking transactions [col. 15 lines 17-19],

generating digital images of the paper-based banking transaction [col. 4 lines 26-42; col. 8 lines 9-67];

for each of the second records, assigning a unique second item sequence number to each respective second record [col. 13 lines 44-49], and

correlating the first and second records [col. 1 lines 58-65 – see reconcile the invoice and the payment].

Geer does not explicitly disclose discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number, wherein the second records and the digital images (record) are linked to the records by the first item sequence number.

However, Gruenwald discloses this feature [Figures 7, 10, 12; col. 1 line 60 to col. 2 line 8; col. 2 lines 38-47; col. 4 lines 55-59; col. 10 lines 48-62 – see correlation across various data fields] to remove duplicate, defective or not used records and improve the memory usage of the database. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Geer and include discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number, wherein the second records and the digital images (record) are linked to the records by the first item

Art Unit: 3693

sequence number, as disclosed by Gruenwald, to use standard database maintenance procedure and discard duplicate or redundant information to improve memory usage and the performance of the database.

Re. Claim 2, Geer discloses further comprising performing financial processing with respect to each of the first records [Geer -col. 3 lines 30-55; col. 4 lines 26-42].

Re. Claim 3, Geer discloses wherein the financial processing comprises posting the banking transaction [Geer- col. 3 lines 30-55; col. 4 lines 26-42].

Re. Claim 4, Geer discloses wherein the step of correlating the first and second records further comprises performing a proofing process [col. 1 lines 58-65; col. 5 lines 10-13]

Re. Claim 5, Gruenwald, further discloses prior to the proofing process, sorting the ECP file (raw data) according to a key to generate an index file, wherein the order of the seconds is thereby irrelevant in the proofing process [Figure 12; col. 1 lines 18-36; col. 8 line 52 to col.9 line 5]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Geer, and include the above feature, as disclosed by Gruenwald to identify duplicate data between the fields.

Art Unit: 3693

Re. Claim 6, Geer discloses wherein the key is selected from the group consisting an account number, a transit number, amount, check number, posting date, the first item sequence number and a payor bank number, each being associated with the paperbased banking transaction [Geer - col. 7 lines 38-62].

Re. Claim 8, Geer discloses further comprising storing the digital images in an archive [col. 8 lines 10-67; col. 15 lines 17-19; col. 17 lines 5-8].

Re. Claim 9, Geer discloses further comprising generating first digital images of paperbased banking transactions that were not represented in the ECP file (electronic files that mirror paper cash letters and detail records) [col. 4 lines 26-42; col. 8 lines 9-67].

Re. Claim 10, Geer discloses generating second digital images of the paper-based banking transactions that were represented in the ECP file, and storing the first and the second digital images in an archive [col. 8 lines 9-67; col. 15 lines 7-19; col. 17 lines 5-8].

Re. Claim 36, claim 36 is rejected with same rational as claim 1.

Re. Claim 37, claim 37 is rejected with same rational as claim 2.

Re. Claim 38, claim 38 is rejected with same rational as claim 3.

Re. Claim 39, claim 39 is rejected with same rational as claim 4.

Art Unit: 3693

Re. Claim 40, claim 40 is rejected with same rational as claim 5.

Re. Claim 41, claim 41 is rejected with same rational as claim 6.

Re. Claim 43, claim 43 is rejected with same rational as claim 8.

Re. Claim 44, claim 44 is rejected with same rational as claim 9.

Re. Claim 45, claim 45 is rejected with same rational as claim 10.

### ***Response to Arguments***

Applicant's arguments filed 5/18/07 have been fully considered but they are not persuasive.

In response to applicant's argument (page 6) recitation "Geer fails to show a correlation between the electronic image at 7 and the scanned information at 6." Applicant argues about limitation which is not claimed. The claimed language of the limitation (claim 1) is "correlating the first and second records". Office action (paper number 20070220) pages 3-4 reads "Re. Claim 1, Geer discloses ... correlating the first and second records [col. 1 lines 58-65 - see reconcile the invoice and the payment.]" and col. 10 lines 50-57 reads "In the example depicted in FIG. 2, electronic transfer and processing of payments occur and paper checks follow at some later time for confirmation, reconciliation and storage by the payor bank and/or for return to the drawer." Reconciliation of paper check and ECP is done only when the paper check and ECP entry is correlated otherwise payment cannot be reconciled.

Art Unit: 3693

In response to applicant's argument (page 6) recitation "Geer fails to show at least the step "discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number." This feature is disclosed by secondary reference "Gruenwald, see paper number 20070220 page 4.

In response to applicant's argument (page 7) recitation "Geer further fails to show "receiving the paper-based banking transactions after having received the ECP file." The excerpt relied upon by the Office Action fails to show that paper-based banking transactions are received after the ECP file." See Geer col. 5 lines 10-45 "Another embodiment of the ... sends the paper check after ... " and col. 10 lines 50-57. Examiner provides references to help applicant to at least review those relevant sections, Applicant is require to consider entire document. Further, Applicant has not presented any evidence that paper checks do not follow the ECP.

In response to applicant's argument (page 7) recitation "Further, Gruenwald fails to disclose this missing claim recitation." Is not clear what the applicant is referring to? Gruenwald is secondary reference which discloses "discarding the second item ..." see paper number 20070220 page 4.



In response to applicant's argument (page 7) recitation "Geer also fails to show the step of "correlating the first and second records." ..." See supra

In response to applicant's argument (page 7) recitation "Accordingly, the Office Action has failed to properly address each and every recitation of the claims. Applicant failed to show which limitation is missing and not addressed. The rejection is made properly under 35 USC 103 Geer (primary reference) in view of Gruenwald (secondary reference is analogous art).

In response to applicant's argument (page 7) recitation "Grunewald's disclosure fails to address the step of "discarding the second item sequence numbers such that the second records are indexable according to the first item sequence number wherein the second records and the digital images are linked to the first records by the first item sequence number." ..." Gruenwald (secondary reference) relates to computerized database which is known for correlating records, sorting records by different fields, indexing and locating records [figure 7 (correlate data record within set), figure 10 (sort by fields and common values between them - correlate), figure 12 (sort, common value); col. 1 line 60 to col. 2 line 8; col. 2 lines 38-47; col. 4 lines 55-59; col. 10 lines 48-62], Gruenwald discloses discarding unnecessary data, since sequence numbers are data and are redundant, disclosure of Gruenwald reads on this limitation.

In response to applicant's argument (page 8) recitation "The Office Action has failed to provide a proper statement of motivation for combining the disparate references. Instead, the alleged statements of motivation are based on improper hindsight."

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, using standard database maintenance procedure and discard duplicate or redundant information to improve memory usage and the performance of the database.

If discarding one of the sequence number does not improve the process and database performance why discarded. Using one reference makes it easier to refer to a record over 2 or more related references, speed dialing is faster than punching all numbers, using index to query a record is quicker than non-indexed table which improves database performance.

In response to applicant's argument "disparate references", that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In response to applicant's argument "hindsight" that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass  
Examiner  
Art Unit 3693



7/18/07